

-6-

REMARKS

The Examiner has rejected Claims 13-17, and 18-19 under 35 U.S.C. 101, as being directed to non-statutory subject matter. Such rejection has been avoided by virtue of the clarifications made hereinabove the claims. Further, with respect to Claims 13-17, applicant disagrees with the Examiner's assertion that such claims are in means plus function format.

The Examiner has rejected Claims 1-21 under 35 U.S.C. 103(a) as being unpatentable over Townshend, U.S. Patent No. 6,829,635. Applicant respectfully disagrees with this rejection, especially in view of the amendments made hereinabove to the claims. Specifically, the subject matter of Claims 6-7 et al. has been substantially incorporated into each of the independent claims.

In the latest action, the Examiner admits that Townshend fails to explicitly teach applicant's claimed "removing non-static data from the electronic mail message" (see each of the independent claims). The Examiner goes on to cite the following excerpt from Townshend, and asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time of invention to suggest that these portions consist of a single paragraph, from a single paragraph of a given size, from a set of words in an electronic mail message that are in a dictionary, or from words appearing a given number times, or from all of an electronic mail message but the first and last n lines."

"Signature generator 120 generates message signature 260, which may include one or more signature elements 270. In one embodiment of the present invention, signature generator 120 generates one or more signature elements 270 by applying a one way hash function to a portion of electronic mail message 210. For example, signature generator 120 may read data from a portion of body part 232, and apply a first one-way hash function to the read data to produce element 272. Likewise, signature generator 120 may read data from a portion of body part 234, and apply a second hash function to produce element 274.

Alternatively, signature generator 120 may read portions of multiple body parts within electronic mail message 210, apply a hash value function to the read data to generate element 272.

-7-

Likewise, signature generator 120 may read other portions of multiple body parts within electronic mail message 210, and apply a hash function to the read data to generate element 274.

There are numerous other mechanisms or techniques that may be used to generate a message signature. For example, a signature element may be generated from a single paragraph, from a single paragraph of a given size, from a set of words in an electronic mail message that are in a dictionary, or from words appearing a given number times, or from all of an electronic mail message but the first and last *n* lines." (See col. 6, lines 40-65)

Applicant respectfully disagrees with this assertion. Simply nowhere in the Townshend reference is there even a suggestion of any sort of "removing non-static data from the electronic mail message." The mere suggestion of selecting multiple elements for generating an electronic mail message signature in no way equates to applicant's claimed removal of non-static data, as claimed.

Nevertheless, despite this paramount deficiency in Townshend and in the spirit of expediting the prosecution of the present application, applicant has incorporated into each of the independent claims the subject matter of former Claims 6-7 et al. Specifically, now claimed is:

"removing non-static data including end-of-line characters and headers, from the electronic mail message" (emphasis added, see all of the independent claims.

With respect to such subject matter of former Claims 6-7, the Examiner has admitted that Townshend fails to explicitly disclose such features, but then cites the foregoing excerpt from Townshend in an effort to render the instant claim limitations as being obvious.

Applicant respectfully disagrees with this assertion. First, it is noted that Townshend only suggests the selective *inclusion* of certain elements, not the removal of non-static data, so that the remaining data may only be used in the generation of the checksum. Further, Townshend makes absolutely no mention of removing end-of line characters and headers, as claimed.

-8-

In fact, Townshend specifically discloses creating a hash for each of the different electronic message parts, including the header, so that bulk mail may be better identified. Thus, Townshend *teaches away* from any sort of removal of headers.

To this end, only applicant teaches and claims a technique to remove the foregoing message parts which are typically tampered with and/or forged by “spammers.” To further emphasize this distinction, applicant now teaches and claims, in each of the independent claims, the following subject matter:

“wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data does not compromise the identification of the electronic message as the unsolicited message.”

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the first and third element of the *prima facie* case of obviousness have not been met, since the prior art reference fails to teach or suggest all the claim limitations, AND Townshend *teaches away* from applicant’s claims. A notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

-9-

It is further noted that the Examiner's rejection of applicant's dependent claims is replete with deficiencies. Just by way of example, the Examiner has admitted that Townshend fails to explicitly disclose applicant's claimed, "wherein comparing a checksum comprises comparing checksums starting with one of the portions at the end of the remaining data and working backwards through the data" (see Claim 4 et al.). The Examiner continues by arguing that "it would have been obvious to one of ordinary skill in the art at the time of invention to assume that since Townshend teaches that multiple signatures (*checksums*) can be created from the body of an email that one way of comparing the signatures for a suspect email would have been to check them by working backwards through the data. The benefit would have been to avoid any schemes that senders of such email might include at the beginning of the body of the email that would prevent the email as being detected as bulk or unsolicited."

Applicant respectfully disagrees with this assertion. Townshend in no way even suggests such backwards processing. Moreover, such feature would not be obvious, in view of the advantages thereof, namely in order to reduce required processing.

Again, applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference fails to teach or suggest all the claim limitations. A notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

Still yet, applicant brings the Examiner's attention to the following subject matter in the added dependent claims, for full consideration:

"wherein the forwarding information includes a ">" character" (see Claim 22);

"wherein the comparing starts with one of the portions at the end of the remaining data and works backwards through the data, in order to reduce required processing" (see Claim 23);

-10-

"wherein the non-static data is removed prior to the checksum being generated"
(see Claim 24); and

"wherein the non-static data is removed to prevent the non-static data from being
subject to the checksum, so that non-static data forged by spammers does not
compromise the identification of the electronic message as the unsolicited
message."

Again, a notice of allowance or a specific prior art showing of each of the
foregoing limitations, in combination with the remaining claim elements, is respectfully
requested.

To this end, all of the pending independent claims are deemed allowable, along
with any dependent claims depending therefrom.

Reconsideration is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this
application, the Examiner may reach the undersigned at (408) 505-5100. Applicants are
enclosing a check to pay for the added claims. The Commissioner is authorized to charge
any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order
No. NAI1P315).

Respectfully submitted,
Zilka-Kotab, PC

Kevin J. Zilka
Registration No. 41,429.

P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100